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Filing date: **11/12/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91223882
Party	Defendant Samsung Electronics Co., Ltd.
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Submission	Motion to Consolidate
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Date	11/12/2015
Attachments	Applicant's Motion to Consolidate Opposition Nos. 91223882 and 91223940.pdf(85254 bytes )

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Serial No.: 86391852  
Mark: EXPRESS ME  
Filed: September 11, 2014  
Published: March 17, 2015

EXPRESS COMMUNICATIONS, LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91223882
	)	Opposition No. 91223940
SAMSUNG ELECTRONICS CO., LTD.	)	
	)	<b>MOTION TO CONSOLIDATE</b>
	)	
Applicant.	)	

**APPLICANT SAMSUNG ELECTRONICS CO., LTD.’S  
MOTION TO CONSOLIDATE OPPOSITION NOS. 91223882 AND 91223940**

Applicant Samsung Electronics Co., Ltd., through its attorneys IpHorgan Ltd., respectfully moves the Board, pursuant to Federal Rule of Civil Procedure 42(a) and TBMP § 511, to consolidate Opposition No. 91223882 involving Application No. 86/391852 (“852 Application”) and Opposition No. 91223940 involving Application No. 85/799934 (“934 Application”). Because the parties, asserted registrations, and alleged grounds for opposition are identical, consolidation would result in a saving of time, effort, and expense. And, because Applicant has recently filed Answers in each of the oppositions, discovery has not commenced and consolidation will not result in prejudice or inconvenience to either party. Accordingly, the Board should grant Applicant’s Motion to Consolidate.

Under Rule 42(a) and TBMP § 511, the Board has discretion to grant a motion to consolidate where the cases to be consolidated involve common issues of law or fact. To determine whether consolidation is appropriate, the Board weighs the expected saving of time,

effort, and expense against any prejudice or inconvenience that may result from consolidation. TBMP § 511.

Here, the two oppositions sought to be consolidated are virtually identical in substance and form, each alleging priority and the single ground of likelihood of confusion. In each case, Opposer, Express Communications, LLC, asserted the same registrations it purportedly owns, U.S. Registration Nos. 3937502, 3913116, and 3026855. The legal issues will be the same, and discovery will involve many of the same facts. Consolidation would result in efficient use of the parties' and Board's resources and necessarily save time and money.

The legal and factual identity between the two oppositions, and the resulting saving of resources through their consolidation, is further demonstrated when considering the legal and factual issues involved in Applicant's Counterclaims of Abandonment filed against each of the asserted registrations in its Answer in Opposition No. 91223940.<sup>1</sup> The legal and factual analysis of the Counterclaims will be identical in each case; consolidation would obviate the expense Applicant would incur in amending its Answer in the earlier-filed Opposition No. 91223882 to include its compulsory counterclaims. In sum, the parties are the same; the legal issues of likelihood of confusion and abandonment present in the two cases are identical; and, even allowing for different applications, fact discovery will be largely redundant. On this basis, consolidation is clearly supported, and the Board should grant Applicant's motion. *See, e.g., Federated Dep't Stores, Inc. v. Gold Circle Ins. Co.*, 226 USPQ 262, 263 (TTAB 1985) (finding "issues of fact and law . . . substantially similar" and granting motion to consolidate where

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<sup>1</sup> Results of a commercial investigation showing non-use/abandonment of Opposer's asserted registrations were received too late to be incorporated into Applicant's Answer in Opposition No. 91223882 but in time to support Applicant's Counterclaims of Abandonment in its subsequently filed Answer to Opposition No. 91223940.

Opposer asserted the same marks and alleged likelihood of confusion against Applicant's two applications).

Further, Consolidation would prejudice neither party. The proceedings are in their early stages – discovery has not commenced. Applicant filed its Answer on October 26, 2015, to Opposition No. 91223882 against Applicant's '852 Application. Three days later, on October 29, 2015, Applicant filed its Answer and Counterclaims in Opposition No. 91223940 against the '934 Application. Although the Board's docket for each is not identical, they are similar. Consolidation would likely aid the parties in eliminating the slightly staggered schedules.

Accordingly, Applicant respectfully requests that the Board grant Applicant's Motion to Consolidate Opposition Nos. 91223882 and 91223940.

In addition, Applicant respectfully requests that the Board briefly suspend for good cause Opposition No. 91223882. 37 C.F.R. § 2.117(c). As described in Footnote 1, Applicant now has grounds to support Counterclaims for Abandonment in Opposition No. 91223882. Because these counterclaims are compulsory, and the date Applicant may file an amended answer as a matter of course to include the counterclaims is November 16, 2015, Applicant asks that the Board suspend the proceeding until it rules on the pending Motion to Consolidate.

DATED this Twelfth day of November, 2015.

Respectfully submitted,

/Christopher B. Lay/  
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

EXPRESS COMMUNICATIONS, LLC,	)	
	)	
Opposer,	)	
	)	
v.	)	Opposition No. 91223882
	)	Application Serial. No. 86391852
SAMSUNG ELECTRONICS CO., LTD.	)	Mark: EXPRESS ME
	)	
	)	
Applicant.	)	

**CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copy of the foregoing APPLICANT SAMSUNG ELECTRONICS CO., LTD.'S MOTION TO CONSOLIDATE OPPOSITION NOS. 91223882 AND 91223940 has been served on the Opponent's Attorney of Record, Matthew M. Googe, by mailing said copy on November 12, 2015, via First Class Mail, postage prepaid, to:

Matthew M. Googe  
Robinson IP Law, PLLC  
9724 Kingston Pike, STE 1403  
Knoxville, TN. 37922

/Christopher B. Lay/  
Christopher B. Lay

11/12/15  
Date